

REMARKS

This is in response to the Office Action that was mailed on September 20, 2006. Table 1 in the specification is amended to specify the units for the viscosity data – see e.g. lines 11-17 on page 9 of the specification. Claim 7 is amended in accordance with the disclosure. See for instance the working Examples, which teach that the reaction solution is directly subjected to vacuum distillation. No new matter is introduced by this Amendment. Entry of this Amendment – in order to place the application into condition for allowance or into better condition for appeal – is earnestly solicited. Claims 7-9 remain pending in the application.

Claim 8 was rejected under the first paragraph of 35 U.S.C. §112 as exceeding the scope of the enabling disclosure. Office Action, page 2. The rejection is respectfully traversed. Viscosities of all of the polyethersilicone compositions prepared in the Examples are shown in Table 1. The Examiner will note that the specifically exemplified viscosities range from 4.9 mm<sup>2</sup>/s to 9.7 mm<sup>2</sup>/s. Persons skilled in the art are enabled to make polyethersilicone compositions having the viscosities recited in claim 8 (1 to 20 mm<sup>2</sup>/s) by the generic teachings and the Examples in the present specification. That is, a person skilled in the art needs only to repeat the procedures described in the specification and the Examples. It is noted that the polyethersilicones described in the Examples may be regarded as compositions of matter because, due to the manner in which they are prepared, they contain matter in addition to the polyethersilicone itself. For instance, Polyethersilicone A contains 2.2% volatiles and 5% free polyether. Thus Applicant respectfully submits that – contrary to the Examiner's assertion –

reasonable enablement of the use of a composition of matter comprising polyethersilicone having the specified viscosity is provided by the present specification.

Claims 7-9 were rejected as being anticipated by or obvious from US 5,288,831 (Ichinohe et al.). Office Action, pages 3-5. The rejections are not applicable to the claims as amended herein.

The Examiner appears to agree that the crux of the Ichinohe et al. technology is to treat the post-reaction solution with an aqueous solution having a pH no greater than 7, as described in lines 30-34 of column 4. Office Action, page 5, 2<sup>nd</sup> full paragraph ("it appears that Ichinohe's vacuum distillation is performed on the post-reaction solution"). Therefore, a person of ordinary skill in the art would not be motivated by the reference to subject the reaction mixture itself to distillation.

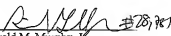
The Examiner argues, however, that "the claimed invention does not exclude the possibility of treating the post-reaction solution with an aqueous solution having a specific pH value". Office Action, page 5, 4<sup>th</sup> full paragraph. Accordingly, Applicant has amended the claim to recite the term "directly", thereby excluding the possibility of treating the post-reaction solution with an acid solution. As amended, the present claims are undeniably novel and unobvious over Ichinohe.

The presently claimed method succeeds in saving a treatment step with an acidic solution, by using a specific polyether of the formula (3) or (4). There is absolutely no foreshadowing of this important benefit in the Ichinohe disclosure. Withdrawal of the rejection of record is earnestly solicited.

If any questions arise regarding the above matters, please contact Applicant's representative, Richard Gallagher (Reg. No. 28,781) at (703) 205-8008.

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Respectfully submitted,

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